

## REMARKS

Claims 1, 3-6, 8-22, 25, 26, and 28-38 are pending in the application. All of the claims have been rejected by the Examiner under Section 103. Most recently the Examiner has reiterated arguments previously made in reliance on the same cited prior art references. Applicant traverses the rejection based on arguments and legal analysis previously of record, previously submitted objective evidence of nonobviousness and the newly submitted additional objective evidence of nonobviousness. Applicant respectfully urges the Examiner to withdraw the rejection.

### **35 U.S.C. § 103(a) REJECTION OF CLAIMS 1, 14, 19-22, 25, 28, 33-35, 37 AND 38 OVER BOBRICK IN VIEW OF MARSHALL**

The Examiner rejected claims 1, 14, 19-22, 25, 28, 33-35, 37 and 38 under 35 U.S.C. § 103(a) as being unpatentable over Bobrick in view of U.S. Patent No. 1,625,041, issued to Marshall. Applicant respectfully traverses this rejection.

Applicant's independent claims recite a "three-dimensional base extending downwardly and outwardly from the three-dimensional member, the base having a peripheral edge shaped to coincide with a scaled space envelope desired for movement of a wheelchair . . ." This language defines over the cited Bobrick and Marshall references. None of the references include a downwardly and outwardly extending three-dimensional base with a peripheral edge defining a space envelope. The Bobrick reference shows a two-dimensional transparent sheet while the Marshall reference shows figurines that include, in some cases, small bases. The bases in the Marshall reference are sized as small as possible to recreate a life-like depiction of an accident scene and thus do not teach having an outwardly extending base shaped to coincide with a scaled space envelope as recited in the independent claims. The shaped based with a peripheral edge is able to move across a design plan of a known scale for functional space planning. Because such base is not taught or suggested by the references cited, Applicant submits that the claims are patentable over the references.

**35 U.S.C. § 103(a) REJECTION OF CLAIMS 3-6, 8, 9, 11-13, 15, 16, 26, 31, 32, AND 36 OVER BOBRICK, MARSHALL, AND STANSBURY**

The Examiner has cited the Stansbury reference as disclosing a roller measure device with a wand/handle member. Stansbury is a full size device not scaled for measuring distances on a plan. Moreover, Stansbury is not combinable with Marshall and Bobrick. The Marshall figurines are sized as small as possible to recreate a life-like depiction of an accident scene, and specifically do not include any wand or handle that would interfere with the movement of other figurines on the accident scene as well as with the visual representation of the object, whether a person, horse or vehicle. Bobrick is a two-dimensional overlay template that is meant to remain stationary. It is simply not possible to connect the handle 44 of Stansbury to propel a “portable mechanical roller measure device for moving forwardly along a surface and thereby measuring a distance there along.” (Stansbury Abstract.) Accordingly, it would not be possible to use the handle 44 of Stansbury with a combination of Marshall and Bobrick to move the objects in the manner required by the Applicant’s claims, namely, to “indicate a turning radius to imitate the turning radius of a support device.”

In addition, for the reasons discussed above with regard to Bobrick and Marshall, these claims are also allowable over the combination of Bobrick, Marshall and Stansbury.

**35 U.S.C. § 103(a) REJECTION OF CLAIMS 10 AND 17 OVER BOBRICK, MARSHALL, STANSBURY AND RIEHLE**

Claims 10 and 17 depend from claims amended herein and are also allowable for the reasons discussed above.

**37 C.F.R. § 1.132 DECLARATIONS**

The Federal Circuit has repeatedly held that a Court (and the Patent Office) must consider objective factors when making an obviousness determination. MPEP 716.01(a); *see, e.g., Pro-Mold and Tool Co., Inc. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573 (Fed. Cir. 1996) (holding that the district court erred for failing to consider factors such as commercial success,

long felt need and failure of others, and copying of the invention by others). Thus, even if the differences between the invention and the prior art initially “appear technologically minor,” the objective indicia can provide a compelling case of nonobviousness. *See Continental Can Co. USA, Inc. v. Monsanto Co.*, 948 F.2d 1264, 1273 (Fed. Cir. 1991).

Based solely on the reasons set forth above, as well as in the many detailed Office Action responses previously submitted, Applicant’s claims are not obvious over Bobrick, further in view of Marshall, Stansbury or Riehle. In addition, Applicant has previously submitted and submits herewith further objective evidence demonstrating that Applicant’s invention is not obvious.

In the Office Action mailed September 23, 2004, the Examiner disputed the sufficiency of four third party declarations of experts in the relevant field along with a declaration of Applicant. Specifically, the Examiner stated that the declarations were not persuasive because: (1) paragraph 4 the Duncan declaration states that Bobrick discloses wheelchair maneuverability and planning; (2) paragraph 5 the Duncan declaration states that static representations cannot be used to show actual maneuverability and that no reasons are used to support this position; (3) the declarations do not provide proper evidence showing the long-felt need, including evidence that others were working on the problem, for how long, and that others would not be able to solve the problem with the teachings of the prior art; (4) the declaration do not provide proper evidence showing commercial success; and (5) the declarations do not show that the objective evidence is commensurate in scope with the claims.

For the reasons detailed below, Applicant disagrees with the Examiner’s conclusion regarding the sufficiency of the previously submitted declarations. In addition, Applicant further submits herewith supplemental declarations of three of the declarants and Applicant, all experts relevant in the field and extremely knowledgeable regarding existing accessibility design tools. These declarations confirm that (1) there has been a long-felt need in the industry for the three-dimensional design tool engagable with a design plan claimed by Applicant; (2) Applicant’s invention meets the long-felt need by providing a design tool that accomplishes the

desired purpose; and (3) there has been substantial commercial success with Applicant's claimed invention. Specifically, in response to the bases cited by the Examiner for the deficiency of the declarations in the Office Action mailed September 23, 2004, Applicant states as follows:

**(1) THE DUNCAN DECLARATION CONFIRMS THAT BOBRICK DOES NOT DISCLOSE WHEELCHAIR MANEUVERABILITY AND PLANNING**

Ms. Duncan's declaration does not support the Examiner's argument that Bobrick discloses wheelchair maneuverability and planning. Rather, it correctly notes that the template product is used in the industry as an overlay on top of plans to "assist with approximating wheelchair spacing." Ms. Duncan later states that the Bobrick plan is used as an overlay on top of plan to "assist with approximating wheelchair maneuverability and planning." (First Duncan Declaration ¶¶ 4-6.) Neither statement is inconsistent with the fact that overlay templates such as Bobrick are merely static overlays that suffer from severe practical limitations that make it difficult if not impossible to demonstrate and visually show how a person using a wheelchair actually maneuvers in spaces using an architectural scale.

**(2) THE DUNCAN DECLARATIONS EXPLAIN WHY STATIC REPRESENTATIONS CANNOT BE USED TO SHOW ACTUAL MANEUVERABILITY**

The First Declaration of Susan M. Duncan explained why the static representations could not be used to show actual maneuverability. As stated in paragraph 5:

Existing design tools for accessibility and space planning suffer from severe practical limitations. Overall, current systems are limited to marking or indicating a static location on a design plan; they do not demonstrate and visually describe the actual movement of a person using a wheelchair or other types of mobility equipment as it negotiates the space. For example, it is difficult if not impossible to demonstrate and visually show how a person using a wheelchair actually maneuvers in spaces using an architectural scale. Using an architectural scale verifies clearances but does not show the movement. Using the Bobrick template as an overlay requires manual manipulation of the template. Hence fingers obscure the visual movement being demonstrated. The same limitations are seen using other types of templates as well as the CAD program: each can be used to mark a location on a drawing or plan with a wheelchair icon footprint, but such static representations cannot be used to show actual maneuverability within the space.

Further elaboration is provided in the Second Declaration of Susan M. Duncan:

A two-dimensional template such as Bobrick is used to mark or indicate a static location on a design plan, thereby providing architectural scale and verifying clearances associated with the wheelchair at that location. However, static templates such as Bobrick do not visually illustrate the actual *movement* of a person using a wheelchair or other types of mobility equipment as it negotiates the space. This is particularly important both when checking existing plans and designing new plans to ensure that the access ways meet accessibility requirements.

Most significant, use of the Bobrick template as an overlay requires manual manipulation of the template. This is accomplished by hand manipulation of the overlay, lifting and placing the overlay at different locations on the design plan, then removing the hands so that the overlay can be viewed on the plans. To simulate visual movement of the overlap requires continuous hand manipulation, which in turn blocks or obscures parts of the template or design plan. In other words, fingers obscure the very visual movement that is sought to be demonstrated. This disadvantage with the Bobrick template is key—obscuring visual movement of the tool prevents the tool from being used to trace wheelchair movement along design plans for the identification and analysis of accessibility issues. The Bobrick template can be used to mark a location on a design plan with a wheelchair icon footprint, but such static representation cannot be used to show actual maneuverability within the space.

(Second Duncan Declaration ¶¶ 5-6.)

**(3) THE DECLARATIONS PROVIDE PROPER EVIDENCE SHOWING THE LONG-FELT NEED**

Evidence of long-felt need and the failure of others is important evidence of nonobviousness that must be considered. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1538 (Fed. Cir. 1983). The evidence should first demonstrate that there was a persistent need that was recognized by those of ordinary skill in the art. *In re Gershon*, 372 F.2d 535, 539 (CCPA 1967). Second, it must demonstrate that the need was not satisfied by another before the invention by Applicant. *Newell Companies v. Kenney Mfg. Co.*, 864 F.2d 757, 768 (Fed. Cir. 1988). Third, the invention must satisfy the long-felt need. *In re Cavanagh*, 426 F.2d 491 (CCPA 1971).

Applicant has submitted declarations evidencing the long-felt need, including evidence of a persistent need in the industry, that the need was not satisfied by another despite more than a decade of attempts, and that Applicant's invention satisfied the long-felt need:

- First and Second Declarations of Susan M. Duncan explain that the need has existed for more than twenty years, and specifically been recognized in the industry since at least as early as 1990; that the need was not satisfied by others in the industry, despite knowledge of the prior art Bobrick templates; and that Applicant's invention satisfies the long-felt need. (First Duncan Declaration ¶¶ 2-8; Second Duncan Declaration ¶¶ 3-8.)
- First and Second Declarations of Sandra Hartje explain that the need has existed for years; that the need was not satisfied by others in the industry, despite knowledge of the prior art Bobrick templates; and that Applicant's invention satisfies the long-felt need. (First Hartje Declaration ¶¶ 3-9; Second Hartje Declaration ¶¶ 2-7.)
- First and Second Declarations of Louis S. Tenenbaum explain that the need has existed for more than twenty years; that the need was not satisfied by others in the industry, despite knowledge of the prior art Bobrick templates; and that Applicant's invention satisfies the long-felt need. (First Tenenbaum Declaration ¶¶ 2-7; Second Tenenbaum Declaration ¶¶ 2-6.)
- Declaration of Rex J. Pace explains that the need has existed for years; that the need was not satisfied by others in the industry, despite knowledge of the prior art Bobrick templates; and that Applicant's invention satisfies the long-felt need. (Pace Declaration ¶¶ 2-5.)
- First and Second Declarations of Michael Miller explain that he has been aware of the need for more than fifteen years; that the need was not satisfied by others in the industry, despite knowledge of static overlays; and that Applicant's invention satisfies

the long-felt need. (First Miller Declaration ¶¶ 2-5; Second Miller Declaration ¶¶ 2-4.)

**(4) THE DUNCAN DECLARATIONS PROVIDE PROPER EVIDENCE SHOWING COMMERCIAL SUCCESS**

Evidence of commercial success is important evidence of nonobviousness that must be considered. *Stratoflex*, 713 F.2d at 1538. There must be a nexus between the claimed invention and the evidence of commercial success. MPEP 716.03(a); *In re Tiffin*, 448 F.2d 791 (CCPA 1971). The commercial success should be the result of the claimed invention rather than the result of heavy promotion or advertising, shift in advertising, etc. *In re Mageli*, 470 F.2d 1380 (CCPA 1973). Commercial success abroad, as well as in the United States, is relevant to the issue of nonobviousness. *Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452 (Fed. Cir. 1984).

The First and Second Declarations of Susan M. Duncan provide adequate evidence of commercial success resulting from the claimed invention. Ms. Duncan specifically describes how the commercial embodiment is the direct product of and exhibits the claimed features of the invention, and that none of the commercial success is attributable to any unclaimed improvements or modifications. Ms. Duncan states the number of unit sales and explains how this number is extremely significant given the industry and the fact that there has been no heavy promotion or advertising or shift in advertising. (First Duncan Declaration ¶ 9; Second Duncan Declaration ¶¶ 9-12.)

**(5) THE DECLARATIONS SHOW THAT THE OBJECTIVE EVIDENCE DERIVES FROM THE CLAIMED INVENTION**

Each of the declarations shows that the objective evidence of nonobviousness is commensurate in scope with the claims by describing how the claimed features are responsible for the advancement over the prior art in meeting the long-felt need and resulting in commercial success. (First Duncan Declaration ¶¶ 8-9; Second Duncan Declaration ¶¶ 2, 7-8, 11; First Hartje

Declaration ¶¶ 6-9; Second Hartje Declaration ¶¶ 4-6; First Tenenbaum Declaration ¶¶ 6-7; Second Tenenbaum Declaration ¶¶ 4-6; Pace Declaration ¶¶ 4-5; First Miller Declaration ¶ 4; Second Miller Declaration ¶¶ 3-4.)

In the present case, both singly and taken as a whole, Applicant submits that the declarations provide persuasive evidence that Applicant's claimed invention is not obvious. Accordingly, each of Applicant's claims should be allowed.

#### CONCLUSION

Applicant submits that the claims are patentable over the prior art. Accordingly, Applicant respectfully requests reconsideration of the application and allowance of the claims.

The Examiner is invited to contact the undersigned should direct communication on this matter be deemed helpful to facilitate progression of the case.

Respectfully submitted,

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